

### **III. REMARKS**

Claims 1-26 are pending in this application. By this amendment, claims 1, 3, 8, 15, 16, 21, 22 and 24 have been amended. Applicant is not conceding in this application that those claims are not patentable over the art cited by the Office, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the subject matter. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 3, 16, 22 and 24-26 are objected to for alleged informalities. Claims 21-26 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Claims 1-26 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stern (U.S. Patent Pub. No. 2002/0032740), hereafter “Stern.”

#### **A. REJECTION OF CLAIMS 1-9 UNDER 35 U.S.C. §101**

The Office has rejected claims 21-26 for allegedly being directed to non-statutory subject matter. Specifically, the Office asserts that the language “a program product stored on a recordable medium” indicated that the program product is not part of the recordable medium. Applicant respectfully disagrees. However, to facilitate expeditious prosecution, Applicants have amended claim 21 to recite “[a] recordable medium having a program product for automatically assigning electronic addresses to users.” Applicant submits that the claim, as amended, satisfies the

Office's interpretation of statutory subject matter. Accordingly, Applicant requests that the rejection be withdrawn.

## **B. REJECTION OF CLAIMS 1-26 UNDER 35 U.S.C. §103(a)**

With regard to the 35 U.S.C. §103(a) rejection over Stern, Applicant asserts that Stern does not teach or suggest each and every feature of the claimed invention. For example, with respect to independent claims 1, 8, 15 and 21, Applicant submits that Stern fails to teach or suggest providing a sequence of address generation scripts, each address generation script including a template that defines a structure for an electronic address. In contrast, in the passage of Stern cited by the Office, an authentic email address is used to attempt to create another email address. To this extent, Stern does not teach or suggest generation scripts that include unique templates that define a structure for an electronic address. Further, to whatever extent, *arguendo*, that the email address in Stern provides some indication of the structure of another email address, all email addresses would indicate the same structure. As such, Stern does not teach generation scripts that each include a unique template.

In contrast, the claimed invention includes "...providing a sequence of address generation scripts, each address generation script including a template that defines a structure for an electronic address." Claim 1. As such, in the claimed invention, the sequence of address generation scripts are not merely sample email address, but rather include templates that each define a structure for an electronic address. Thus, email addresses of Stern do not teach the sequence of address generation scripts. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With further respect to independent claims 1, 8, 15 and 21, Applicant respectfully submits that Stern also fails to teach or suggest one of the address generation scripts produces a previously unused electronic address. In contrast, the passages of Stern cited by the Office indicate that a goal of Stern is to decipher valid email address. To this extent, Stern does not teach or suggest producing a previously unused electronic address. The Office indicates that it would be obvious to integrate a feature such as this into the Stern reference to yield the claimed invention. Applicant asserts that the Office's factual assertion amounts to Official Notice and is not properly based upon common knowledge. For example, Applicant asserts that automatic generation of previously unused email addresses from scripts is not obvious to one skilled in the art as asserted by the Office. Furthermore, the generation of previously unused email addresses is inconsistent with Stern, which seeks to find email addresses that are currently in use. Accordingly, Applicant respectfully requests that the Office support the finding with references that show these features or withdraw the rejection.

With respect to dependent claim 3, Applicant respectfully submits that Stern also fails to teach or suggest the one of the address generation scripts that produces the previously unused electronic address using user data is provided from a repository and wherein the sequence of address generation scripts are generated by a user. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With respect to the Office's other arguments regarding dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. Furthermore, Applicant submits that all dependant claims are

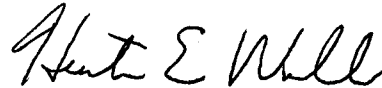
allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

#### **IV. CONCLUSION**

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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Date: September 5, 2007

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